

## REMARKS

Claims 1 and 3-14 are pending in this Application. Though no claims have been amended, Applicant respectfully provides the Examiner with the above listing.

### Objections to the Claims

Claim 14 is objected to for informalities. In response, Applicant respectfully amends claim 14.

### Rejections under 35 U.S.C. §102(e)/103(a)

Claims 1 and 8 have been rejected under 35 U.S.C. §102(e) as being anticipated by, or in the alternative under 35 U.S.C. §103(a) as being obvious over United States Publication No. 2004/0193273 to Huang (“Huang” hereinafter). Applicant respectfully traverses this rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

In addition, for an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicant’s claim 1 recites:

“a compression pad made of at least two compressible materials of different hardness,...wherein volumes disposed outside and inside of the shaft, respectively, are filled with compressible materials of different hardness.”

Huang does not teach a compression pad made of at least two compressible materials of different hardness which fill volumes disposed outside and inside of the shaft, respectively. Instead, referring to paragraphs 0034-0038 and 0051 6, Huang teaches a cushion coupler 3 and a buffer liquid in annular chamber A. In the instant Office Action the Examiner seems to allege that the buffer liquid in chamber A is equitable to one of the at least two compressible materials recited in Applicant's claims. Applicant respectfully traverses this assertion by again noting that the buffer liquid of annular chamber A, like any liquid, *is inherently not compressible*. As such Huang does not teach the two compressible materials recited in Applicant's claim 1.

Accordingly, as Huang does not teach every element of Applicant's claims 1 and 8 (8 depending from 1), Applicant respectfully submits that claims 1 and 8 are not anticipated by, or obvious over, Huang.

With further regards to the obviousness rejection, Applicant respectfully refers the Examiner to paragraph 0038 of Huang, which states that the buffer liquid in annular chamber A penetrates other components of the apparatus "for lubricating the rotational contacting surfaces of the two corresponding elements, including the pivoting ball 14 and spherical recess 34." Thus, if the apparatus of Huang were to be modified to include a non-liquid material in the annular chamber A as opposed to the liquid buffer taught therein, the rotational contacting surfaces of Huang would be rendered inoperable due to a loss of the "lubricating" discussed in paragraph 0038. Accordingly, any modification to Huang that would replace the liquid buffer with one of the non-liquid *compressible* materials recited in Applicant's claims would be improper under MPEP 2143.01V.

Accordingly, Applicant further and respectfully submits that *prima facie* obviousness does not exist regarding claims 1 and 8 with respect to Huang.

#### Rejections under 35 U.S.C. §103(a)

Claims 3, 5-7, and 11-12 have been rejected under 35 U.S.C. §103(a) as being obvious over

Huang. Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 3, 5-7, and 11-12 depend from claim1. Accordingly, for at least the reasons set forth with regards to claim 1 in the 102 discussion, Applicant respectfully submits that Huang does not teach every element of Applicant's claims 3, 5-7, and 11-12. Accordingly, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 3, 5-7, and 11-12 with respect to Huang. Since Huang fails to teach or suggest all of the limitations of claims 3, 5-7, and 11-12, clearly, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify the reference, or a reasonable likelihood of success in forming the claimed invention by modifying. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Claim 4 has been rejected under 35 U.S.C. §103(a) as being obvious over Huang in view of United States Patent No. 6,582,468 to Gauchet ("Gauchet" hereinafter). Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 4 depends from claim1. Accordingly, for at least the reasons set forth with regards

to claim 1 in the 102 discussion, Applicant respectfully submits that Huang does not teach every element of Applicant's claim 4. As Gauchet does not remedy the deficiencies of Huang, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claim 4 with respect to any proposed combination of Huang and Gauchet. Since the proposed combination of Huang and Gauchet fails to teach or suggest all of the limitations of claim 4, clearly, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify or combine the reference, or a reasonable likelihood of success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Claim 9 has been rejected under 35 U.S.C. §103(a) as being obvious over Huang in view of United States Patent No. 4,759,769 to Hedman ("Hedman" hereinafter). Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claim 9 depends from claim 1. Accordingly, for at least the reasons set forth with regards to claim 1 in the 102 discussion, Applicant respectfully submits that Huang does not teach every element of Applicant's claim 9. As Hedman does not remedy the deficiencies of Huang, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claim 9 with respect to any proposed combination of Huang and Hedman. Since the proposed combination of Huang and Hedman fails to teach or suggest all of the limitations of claim 9, clearly, one of ordinary skill at the time of Applicant's invention would not have a motivation to modify or combine the reference, or a reasonable likelihood of success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Claims 10 and 13 have been rejected under 35 U.S.C. §103(a) as being obvious over Huang in view of United States Publication No. 2003/0074067 to Errico (“Errico” hereinafter). Applicant respectfully traverses this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Claims 10 and 13 depend from claim 1. Accordingly, for at least the reasons set forth with regards to claim 1 in the 102 discussion, Applicant respectfully submits that Huang does not teach every element of Applicant’s claims 10 and 13. As Errico does not remedy the deficiencies of Huang, Applicant respectfully submits that *prima facie* obviousness does not exist regarding claims 10 and 13 with respect to any proposed combination of Huang and Errico. Since the proposed combination of Huang and Errico fails to teach or suggest all of the limitations of claims 10 and 13, clearly, one of ordinary skill at the time of Applicant’s invention would not have a motivation to modify or combine the reference, or a reasonable likelihood of success in forming the claimed invention by modifying or combining. Thus, here again, *prima facie* obviousness does not exist. *Id.*

Conclusion

Applicant believes that all of the outstanding objections and rejections have been addressed herein and are now overcome. Entry and consideration hereof and issuance of a Notice of Allowance are respectfully requested.

Applicant hereby petitions for any extension of time under 37 C.F.R. 1.136(a) or 1.136(b) that may be necessary for entry and consideration of the present Reply.

If there are any charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

The Office is invited to contact applicant's attorneys at the below-listed telephone number concerning this Amendment or otherwise regarding the present application.

Respectfully submitted,  
CANTOR COLBURN LLP

By: /Daniel R. Gibson/  
Daniel R. Gibson  
Registration No. 56,539  
CANTOR COLBURN LLP  
20 Church Street  
22<sup>nd</sup> Floor  
Hartford, CT 06103  
Telephone: 860-286-2929  
Facsimile: 860-286-0115  
Customer No. 23413

Date: June 23, 2009